

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christine L. Brakel et al.)
Serial No. 08/479,999)
Filed: June 28, 1994)
Title: MODIFIED NUCLEOTIDE COMPOUNDS)
(As Previously Amended)

Group Art Unit: 1631

Ex'r: Ardin H. Marschel, Ph.D.

527 Madison Avenue, 9th Floor
New York, NY 10022-4304
December 15, 2003

FILED BY EXPRESS MAIL

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P.O. Box 1450
Alexandria, VA 22313-1450

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OFFICE OF PETITIONS

REQUEST FOR RECONSIDERATION OF APPLICANTS
DECEMBER 26, 2001 PETITION UNDER 37 C.F.R. §1.137(b)

Dear Sirs:

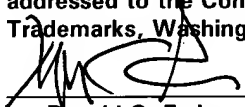
In response to the Decision mailed on October 14, 2003 (copy attached as Exhibit A), Applicants respectfully request reconsideration of their December 26, 2001 Petition Under 37 C.F.R. §1.137(b) to Revive an Unintentionally Abandoned Application. A response to the October 14, 2003 Decision was originally due on December 14, 2003. Because December 14, 2003 falls on a Sunday, under 37 CFR 1.7, a response filed on the next succeeding day which is not a Saturday, Sunday or a federal holiday, is considered timely filed. Accordingly, this response is being timely filed.

Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Page 2 (Request for Reconsideration of Applicant December 26, 2001 Petition
Under 37 C.F.R. §1.137(b) - December 15, 2003)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	<u>EL1905579881US</u>
Deposit Date	<u>December 15, 2003</u>
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.	
 Ronald C. Fedus Reg. No. 32,567	<u>Dec 15 2003</u> Date

Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Page 3 (Request for Reconsideration of Applicant December 26, 2001 Petition
Under 37 C.F.R. §1.137(b) - December 15, 2003)

In the October 14, 2003 Decision, the Petitions Examiner stated:

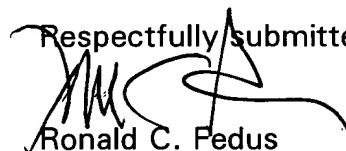
Petitioner's only submission, an amendment, has been determined by the examiner not to prima facie place the application in condition for allowance. Thus, petitioner has failed to submit the required reply.

In response Applicants respectfully point out that their filing on December 26, 2001 included as Exhibit 4 a Notice of Appeal. For the Petition Examiner's review, a complete copy of Applicants December 26, 2001 filing, including the Notice of Appeal (Exhibit 4), is attached as Exhibit B.

No fee or fees are believed due in connection with this response. In the event that any fee or fees are due, however, The United States Patent and Trademark Office is hereby authorized to charge any such fee(s) to Deposit Account No. 05-1135, or to credit any overpayment thereto.

A duplicate copy of this Request for Reconsideration (but without attached Exhibits A and B) is also submitted herewith.

Favorable action on this Request for Reconsideration is respectfully requested.

Respectfully submitted,

Ronald C. Pedus
Registration No. 32,567
Attorney for Applicants

ENZO THERAPEUTICS, INC.
c/o Enzo Biochem, Inc.
527 Madison Avenue (9th Fl.)
New York, New York 10022
Telephone: (212) 583-0100
Fax: (212) 583-0150



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 50

ENZO BIOCHEM INC.
527 MADISON AVENUE (9TH FLOOR)
NEW YORK NY 10022



COPY MAILED

OCT 14 2003

OFFICE OF PETITIONS

In re Application of
Brakel, et al.
Application No. 08/479,999
Filed: June 28, 1994
Title: MODIFIED NUCLEOTIDE
COMPOUNDS

DECISION ON PETITION

This is a decision on the petition to revive the above-identified application under 37 CFR 1.137(b), filed December 26, 2001. The Office apologizes for the delay.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." This is **not** a final agency decision within the meaning of 5 USC 704.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed September 26, 2000, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 27, 2000. A Notice of Abandonment was mailed on July 16, 2001.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d).

The instant petition lacks item (1), the required reply.

With the instant petition, petitioner filed an amendment in response to the final Office action. The proposed reply to a final Office action required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law); (2) an amendment that *prima facie* places the application in condition for allowance; (3) the filing of a continuing application under 37 CFR 1.53(b) or if applicable, 1.53(d); (4) a request for a continuing examination (RCE) under 37 CFR 1.114; or (5) if applicable, a 37 CFR 1.129(a) submission.

Petitioner's only submission, an amendment, has been determined by the examiner not to *prima facie* place the application in condition for allowance. Thus, petitioner has failed to submit the required reply.

In order for the application to be revived, petitioner must submit a required reply within the meaning of 37 CFR 1.137(b)(1). **Any renewed petition should be accompanied by a proper reply in the form of a Notice of Appeal, the filing of a continuation application or an RCE.** If petitioner fails to reply in the form of a Notice of Appeal, a proper continuing application, or a proper RCE, it may be construed as an intentional delay in presenting a grantable petition, which may adversely affect petitioner's ability to revive the abandoned application.

The \$1,280 fee for the petition under 37 CFR 1.137(b) has been charged to Deposit Account No. 05-1135, as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, Virginia

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0272.



Cliff Congo
Petitions Attorney
Office of Petitions

Please date stamp and return to addressee.

APPLICANT: CHRISTINE L. BRAKEL ET AL.

☒ Express Mail Label No.

EL491424303US

TITLE: MODIFIED NUCLEOTIDE COMPOUNDS

☐ First Class Mailing Date

DATE MAILED: DECEMBER 26, 2001

ENCLOSED ARE:

- | | |
|--------------------------------------|--|
| <input type="checkbox"/> Application | <input type="checkbox"/> Response to OA |
| <input type="checkbox"/> Declaration | <input checked="" type="checkbox"/> Amendment UNDER 37 CFR 1.116 |
| <input type="checkbox"/> Drawings | <input type="checkbox"/> Issue Fee |
| <input type="checkbox"/> Assignment | <input checked="" type="checkbox"/> Other (see below) |

☒ PETITION UNDER 37 CFR §1.137(b) TO REVIVE AN
UNINTENTIONALLY ABANDONED APPLICATION

☒ NOTICE OF APPEAL

Serial No. 08/479,999

☒ TRANSMITTAL

Docket No. ENZ-47(C2)

Please date stamp and return to addressee.

APPLICANT: CHRISTINE L. BRAKEL ET AL.

☒ Express Mail Label No.

EL491424303US

TITLE: MODIFIED NUCLEOTIDE COMPOUNDS

☐ First Class Mailing Date

DATE MAILED: DECEMBER 26, 2001

ENCLOSED ARE:

- | | |
|--------------------------------------|--|
| <input type="checkbox"/> Application | <input type="checkbox"/> Response to OA |
| <input type="checkbox"/> Declaration | <input checked="" type="checkbox"/> Amendment UNDER 37 CFR 1.116 |
| <input type="checkbox"/> Drawings | <input type="checkbox"/> Issue Fee |
| <input type="checkbox"/> Assignment | <input checked="" type="checkbox"/> Other (see below) |

☒ PETITION UNDER 37 CFR §1.137(b) TO REVIVE AN
UNINTENTIONALLY ABANDONED APPLICATION

☒ NOTICE OF APPEAL

☒ TRANSMITTAL

Serial No. 08/479,999

Docket No. ENZ-47(C2)



SENDER: COMPLETE THIS SECTION

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
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1. Article Addressed to:

US PATENT & TRADEMARK
OFFICE
P.O. BOX 2327
ARLINGTON, VA
22202

2. Article Number (Copy from service label)

EL491424303US

PS Form 3811, July 1999

Domestic Return Receipt

COMPLETE THIS SECTION ON DELIVERY

A. Received by (Please Print Clearly)

B. Date of Delivery

C. Signature

X

☐ Agent

☐ Addressee

D. Is delivery address different from item 1?

☐ Yes

If YES, enter delivery address below:

☐ No

3. Service Type

☐ Certified Mail

☒ Express Mail

☐ Registered

☐ Return Receipt for Merchandise

☐ Insured Mail

☐ C.O.D.

4. Restricted Delivery? (Extra Fee)

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SENDER: COMPLETE THIS SECTION

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☐ Registered

☐ Return Receipt for Merchandise

☐ Insured Mail

☐ C.O.D.

4. Restricted Delivery? (Extra Fee)

☐ Yes

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22202

2. Article Number (Copy from service label)

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PS Form 3811, July 1999

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EN2-47(C2)

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- A. Received by (Please Print Clearly) B. Date of Delivery
- C. Signature ☒ Agent ☐ Addressee
- D. Is delivery address different from item 1? ☐ Yes ☐ No
- If YES, enter delivery address below:

3. Service Type
- ☒ Certified Mail
 - ☐ Registered
 - ☐ Insured Mail
 - ☐ C.O.D.
 - ☐ Express Mail
 - ☐ Return Receipt for Merchandise
 - ☐ Restricted Delivery? (Extra Fee)
 - ☐ Yes

POST OFFICE
TO ADDRESSEE



UNITED STATES POSTAL SERVICE™

ORIGIN (POSTAL USE ONLY)		DELIVERY (POSTAL USE ONLY)	
PO ZIP Code	Day of Delivery	Delivery Attempt	Time
	<input type="checkbox"/> Next <input type="checkbox"/> Second	Mo. Day	<input type="checkbox"/> AM <input type="checkbox"/> PM
Date In		Delivery Attempt	Time
	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Mo. Day	<input type="checkbox"/> AM <input type="checkbox"/> PM
Mo. Day Year		Delivery Date	Time
	<input type="checkbox"/> 1st Day <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Mo. Day	<input type="checkbox"/> AM <input type="checkbox"/> PM
Weight	Int'l Alpha Country Code	Signature of Addressee or Agent	
No Delivery <input type="checkbox"/> Weekday <input type="checkbox"/> Holiday <input type="checkbox"/>	Acceptance Clerk Initials	Name - Please Print	
Flat Rate Envelope <input type="checkbox"/>			
Postage \$			
Return Receipt Fee \$			
COD Fee \$			
Insurance Fee \$			
Total Postage & Fees \$			

CUSTOMER USE ONLY

METHOD OF PAYMENT: ☒ WAIVER OF SIGNATURE (Domestic Only): Additional merchandise insurance is valid if waiver of signature is requested. With delivery to be made by signature of addressee or agent of delivery employee judges that article can be left in secure location and delivery employee's signature constitutes valid proof of delivery.

NO DELIVERY ☐ Weekday ☐ Holiday

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ENZO BIOCHEM INC/RONALD C. FEDUS
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NEW YORK NY 10022-4304

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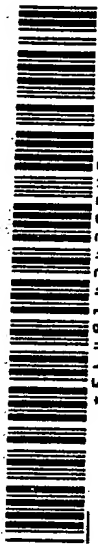
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14/

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NEW YORK, NY 10022-9998
12/26/01 11:24PM

Store USPS	Trans	74
bkstn sys5013	Cashier	KV3K89
Cashier's Name	David	
Stock Unit Id	SIADAVID	
PO Phone Number	212-330-5597	

1. Exp. Mail PO-ADD	0.00
Destination:	22202
Weight:	9.50oz
Postage Type:	Affixed
Affix. Post.:	-17.75
Total Cost:	17.75
Base Rate:	16.25
Label#:	EL491424303US
SERVICES	
Return Receipt	1.50

Subtotal	0.00
Total	0.00

Number of Items Sold: 1

Thank You
Please come again!

POST OFFICE TO ADDRESSEE



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ORIGIN (POSTAL USE ONLY)

PO ZIP Code 10022	Day of Delivery <input type="checkbox"/> Next <input checked="" type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>
Date In 12/26/01	<input checked="" type="checkbox"/> 11 Noon <input type="checkbox"/> 3 PM	Postage \$ 1.62
Time In 2:32 PM	<input type="checkbox"/> 1st Day <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee \$ 0.00
Weight 10 lbs.	Int'l Alpha Country Code	COD Fee \$ 0.00
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials [Signature]	Insurance Fee \$ 0.00
Total Postage & Fees \$ 1.62		

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METHOD OF PAYMENT:

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☐ **WAIVER OF SIGNATURE** (Domestic Only): Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent. (If delivery employee judges that article can be left in secure location and I authorize that delivery employee's signature constitutes valid proof of delivery.)
☐ **NO DELIVERY** ☐ **WEEKEND** ☐ **HOLIDAY**

FROM: (PLEASE PRINT)

ENZO BIOCHEM INC / RONALD C. FEDUS
527 MADISON AVE FL 9
NEW YORK NY 10022-4304
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TO: (PLEASE PRINT)

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ORIGIN (POSTAL USE ONLY)			DELIVERY (POSTAL USE ONLY)		
PO ZIP Code	Day of Delivery <input type="checkbox"/> Next <input type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>	Delivery Attempt	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Date in Mo. Day Year	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Postage \$	Delivery Attempt	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Time in <input type="checkbox"/> AM <input type="checkbox"/> PM	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee	Delivery Date	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Weight lbs. ozs.	Int'l Alpha Country Code	COD Fee Insurance Fee	Signature of Addressee or Agent		
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials	Total Postage & Fees \$	Name - Please Print		
CUSTOMER USE ONLY			NO DELIVERY <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday		
METHOD OF PAYMENT: Express Mail Corporate Acct. No. XXXXXXXXXX			<input type="checkbox"/> WAIVER OF SIGNATURE (Domestic Only): Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.		
Federal Agency Acct. No. or Postal Service Acct. No.			Customer Signature		
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14/
F02
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Title: MODIFIED NUCLEOTIDE COMPOUNDS

(As Previously Amended)

Group Art Unit: 1631

Ex'r: Ardin H. Marschel, Ph.D.

527 Madison Avenue, 9th Floor
New York, New York 10022
December 26, 2001

FILED BY EXPRESS MAIL

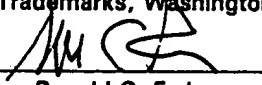
Commissioner of Patents and Trademarks*
Washington, D.C. 20231 Box DAC

Attention: Office of Deputy Assistant Commissioner for Patents
2121 Crystal Drive -- Crystal Park 2 - Suite 913
Arlington, Virginia 22202

PETITION UNDER 37 C.F.R. §1.137(b)
TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION

Dear Sirs:

Applicants submit this Petition to the Commissioner under the provisions of 37 C.F.R. §1.137(b) to revive the above-identified application in which taking

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	<u>EL491424303US</u>
Deposit Date	<u>December 26, 2001</u>
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.	
 Ronald C. Fedus Reg. No. 32,567	<u>DEC 26 2001</u> Date

* In accordance with the November 16, 2001 Notification Related to United States Postal Service Interruption, this paper and all attachments are being sent by Express Mail to: U.S. Patent and Trademark Office, P. O. Box 2327, Arlington, VA 22202. See *Suspension of the "Express Mail" Service of United States Postal Service for mail addressed to ZIP Codes 202xx through 205xx.*

Enz-47(C2)

Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Page 2 (Petition Under 37 C.F.R. §1.137(b) To Revive An Unintentionally Abandoned Application - December 26, 2001)

action was unintentionally delayed. A response to the September 26, 2000 Office Action issued in this application was originally due on December 26, 2000. Upon the expected granting of this Petition, this application will be revive and the accompanying response in the form of an Amendment Under 37 C.F.R. §1.116 will be considered as having been timely filed.

The above-identified application became unintentionally abandoned after December 26, 2000, which was the date that a response to the September 26, 2000 Office Action was originally due. A Notice of Abandonment was subsequently mailed on July 16, 2001. A copy of the July 16, 2001 Notice of Abandonment is attached to this Petition as Exhibit 1. A Terminal Disclaimer To Accompany Petition is also attached to this paper as Exhibit 2.

It is hereby requested that this application be revived because the entire delay in filing the response to the September 26, 2000 Office Action until the filing of this Petition was unintentional. As indicated above, a response to the September 26, 2000 Office Action in the form of an Amendment Under 37 C.F.R. §1.116 is being submitted concurrently herewith and is attached as Exhibit 3. A Notice of Appeal is also attached to this paper as Exhibit 4.

The fee for filing a Petition to Revive an Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b) is \$1,280.00 for a large entity. The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for the requisite large entity fee of \$1,280.00. The Patent and Trademark Office is further authorized hereby to charge Deposit Account No. 05-1135 for any other fees required in connection with this Petition and the attached Amendment, or to credit any overpayment thereto.

A duplicate copy of this Petition but without attached Exhibits 1-4 is also submitted herewith.

Christine L. Brakel et al.

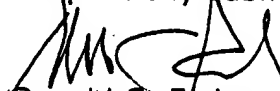
Serial No. 08/479,999

Filed: June 28, 1994

Page 3 (Petition Under 37 C.F.R. §1.137(b) To Revive An Unintentionally
Abandoned Application - December 26, 2001)

Favorable action on this Petition is earnestly solicited.

Respectfully submitted,



Ronald C. Fedus

Registration No. 32,567

Attorney for Applicants

ENZO THERAPEUTICS, INC.

c/o Enzo Biochem, Inc.

527 Madison Avenue (9th Fl.)

New York, New York 10022

Telephone: (212) 583-0100

Fax: (212) 583-0150



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/479,999 06/28/94 BRAKEL

C ENZ-47 (C)

028171

HM22/0716

ENZO BIOCHEM, INC.

527 MADISON AVENUE (9TH FLOOR)

NEW YORK, NY 10022

EXAMINER

MARSCHER, A

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

07/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Notice of Abandonment

Application No.
08/479,999

Applicant(s)
Brakel et al.

Examiner
Ardin Marschel

Art Unit
1631




-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on Sep 26, 2000.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ No response has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance.
 - (b) ☐ The submitted issue fee of \$ _____ is insufficient. A balance of \$ _____ is due.

The issue fee required by 37 CFR 1.18 is \$ _____. The publication fee, if required by 37 CFR 1.18(d) is \$ _____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file new formal drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed new formal drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ The proposed new formal drawings filed on _____ are not acceptable and the period for reply has expired.
 - (c) ☐ No proposed new formal drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


ARDIN H. MARSCHEL
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO ACCOMPANY PETITION

Docket Number (Optional)

In re Application of: Christine L. Brakel et al.

Name:

Application Number: 08/479,999

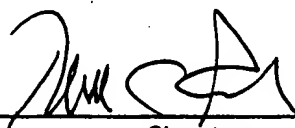
Filed: June 28, 1994

For: Modified Nucleotide Compounds

The owner*, _____ of _____ percent interest in the above-identified application hereby disclaims a terminal part of the term of any patent granted the above-identified application equivalent to: (1) if the above-identified application is a design application, the period of abandonment of the above-identified application, and (2) if the above-identified application is a utility or plant application, the lesser of: (a) the period of abandonment of the application; or (b) the period extending beyond twenty years from the date on which the above-identified application was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed. This disclaimer also applies to any patent granted on a utility or plant application filed before June 8, 1995, or a design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above-identified application. This disclaimer is binding upon the grantee, and its successors or assigns.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.
2. ☒ The undersigned is an attorney or agent of record.



Signature

12/26/01

Date

Ronald C. Fedus

Typed or printed name
Reg. No. 32,567

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

☒ The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for **
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

** the Terminal Disclaimer fee under 37 C.F.R. 1.20(d) and for any other required fees.

* Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).

Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Christine L. Brakel et al.
Serial No. 08/479,999 Group Art Unit: 1631
Filed: June 28, 1994 Ex'r: Ardin H. Marschel, Ph.D.
Title: MODIFIED NUCLEOTIDE COMPOUNDS (As Previously Presented)

FILED VIA EXPRESS MAIL

Honorable Commissioner of
Patents and Trademarks
Washington, D. C. 20231

Sir:

Transmitted herewith is an Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) in the above-identified patent application.

The fee* has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
Total	51	Minus	52	=0	X \$9	\$ 0.00
Indep	5	Minus	6	=0	X \$42	\$ 0.00
()	First Presentation of Multiple Dependent Claims				\$ 140	\$ 0.00
	TOTAL ADDITIONAL FEE					\$ 0.00

*Small entity status was previously established in this application and is still applicable.

- () Charge Deposit Account No. 05-1135 in the amount of \$ _____
- () A check in the amount of \$ _____ is attached.
- (X) The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 05-1135 any filing fees under 37 C.F.R. §1.16 for the presentation of extra claims and any patent application processing fees under 37 C.F.R. §1.17.

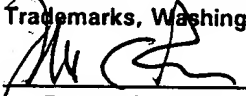
Copies are being provided in triplicate.

Christine L. Brakel et al.

Serial No.: 08/479,999

Filed: June 28, 1994

Page 2 (Transmittal -- December 26, 2001)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	<u>EL491424303US</u>
Deposit Date	<u>December 26, 2001</u>
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.	
	<u>DEC 26 2001</u>
Ronald C. Fedus Reg. No. 32,567	Date

Christine L. Brakel et al.

Serial No.: 08/479,999

Filed: June 28, 1994

Page 3 (Transmittal -- December 26, 2001)

Also enclosed: Petition Under 37 C.F.R. §1.137(b) & Notice of Appeal.

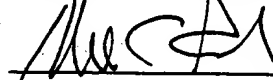
December 26, 2001

Date

ENZO THERAPEUTICS, INC.
c/o Enzo Biochem, Inc.
527 Madison Avenue (9th Fl.)
New York, New York 10022
Tel. (212) 583-0100

Attorney's Docket No.: Enz-47(C2)

Respectfully submitted,



Ronald C. Fedus

Registration No. 32,567

Attorney for Applicant(s)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Title: **MODIFIED NUCLEOTIDE COMPOUNDS)**
(As Previously Presented)

Group Art Unit: 1631

Ex'r: Ardin H. Marschel, Ph.D.

527 Madison Avenue, 9th Floor
New York, New York 10022
December 26, 2001

FILED VIA EXPRESS MAIL

Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

**AMENDMENT UNDER 37 C.F.R. §1.116
(IN RESPONSE TO THE SEPTEMBER 26, 2000 OFFICE ACTION)**

Dear Sirs:

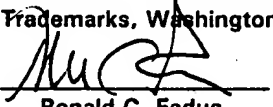
Please enter this response (Amendment Under 37 C.F.R. §1.116) to the Office Action mailed on September 26, 2000 in connection with the above-identified application. A response to the September 26, 2000 Office Action was originally due by December 26, 2000. This response is accompanied by a Petition Under 37 C.F.R. §1.137(b) and authorization for the fee therefor. Accordingly, upon granting of Applicants' Petition, this response (Amendment) will be considered as having been being timely filed.

Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Page 2 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26,
2000 Office Action) - December 26, 2001]

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	<u>EL491424303US</u>
Deposit Date	<u>December 26, 2001</u>
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.	
 Ronald C. Fedus Reg. No. 32,567	<u>DEC 26 2001</u> Date

Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Page 3 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

KINDLY AMEND THIS APPLICATION AS FOLLOWS:

In The Title:

Please substitute the following title of the invention:

-- MODIFIED RNase H NUCLEOTIDE COMPOUNDS -- .

In the Claims:

Please enter replacement claims 1, 18, 19, 21, 37, 41 and 51 as follows:

Clean Version of Replacement Claims

1. (Four Times Amended) A modified RNase H resistant nucleotide compound which includes at least one component selected from the group consisting of MN_3M , $B(N)_xM$ and $M(N)_xB$ wherein

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2.

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Serial No. 08/479,999

Filed: June 28, 1994

Page 4 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

18. (Twice Amended) The modified nucleotide compound of claim 1 which includes at least one sequence of the formula $M(N)_x B$ wherein B is modified or unmodified 2',3'-dideoxyribose nucleotide.

19. (Twice Amended) The modified nucleotide compound of claim 1 wherein x is an integer selected from the group consisting of 2 or 2.

21. (Four Times Amended) A method of inhibiting the function of an RNA, which comprises:

contacting said RNA, under conditions permissive of hybridization, with a modified RNase H resistant nucleotide compound which includes at least one complementary component selected from the group consisting of MN_3M , $B(N)_x M$ and $M(N)_x B$ wherein:

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2.

37. (Twice Amended) The method of claim 21 wherein the RNA is contacted with a compound which includes at least one sequence of the formula $M(N)_x B$ wherein B is modified or unmodified 2',3'-dideoxyribose nucleotide.

41. (Twice Amended) A method of treating a human or animal so as to inhibit the function of a target RNA therein which method comprises administering a therapeutically effective amount of a modified nucleotide compound so as to inhibit the function of the target RNA, which modified RNase H resistant nucleotide compound includes at least one component selected from the group consisting of MN_3M , $B(N)_xM$ and $M(N)_xB$ wherein:

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2.

51. (Twice Amended) A modified nucleotide compound which comprises at least one component selected from the group consisting of MN_3M , $B(N)_xM$ and $M(N)_xB$ wherein:

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2.

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Filed: June 28, 1994

Page 6 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26,
2000 Office Action) - December 26, 2001]

Cancel claim 52.

* * * * *

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Serial No. 08/479,999

Filed: June 28, 1994

Page 7 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-52 were previously pending. Replacement claims 1, 18, 19, 21, 37, 41 and 51 have been entered above. Claim 52 has been canceled. No claim has been added by this paper. Accordingly, claims 1-51 as amended hereinabove are presented for further examination on the merits.

Acknowledgement is made that the art unit designated for this application has been changed. Any and all future correspondence will henceforth be directed to Group Art Unit 1631.

In a sincere effort to define their invention more clearly and to narrow the issues on appeal or place claims in an allowable condition, Applicants have amended the claims above. The amendments have restored the originally claimed subject matter in the form of components selected from the group consisting of MN_3M , $B(N)_xM$ and $M(N)_xB$. Moreover, in amending the claims above, Applicants have also expunged the subject matter deemed new matter in the outstanding September 26, 2001 Office Action. The instantly recited components are supported variously in the specification, including the originally filed claims.

In addition, Applicants are also now covering those compositions as defined in the present claims which are modified RNase H resistant nucleotide compounds. The language "RNase H resistant" is also variously supported by Applicants' original disclosure.

Entry of the above amendments to the claims is believed to be appropriate and necessary. First, these amendments do not raise new issues that would require further consideration and/or search by the Examiner. In particular, the amendments to the independent claims (1, 21, 41 and 51) with respect to the

Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Page 8 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

component(s) recited in Applicants' claimed modified RNase H resistant nucleotide compounds, serve to advance prosecution by addressing an issue or issues raised in the September 26, 2000 Office Action. Further, no issue of new matter is raised by the entry of these amendments, since the subject matter corresponds to the original disclosure, including the originally filed claims. Moreover, it is believed that the amendments will actually serve to place this application in better form for appeal by materially reducing or simplifying the issues for appeal. Finally, the amendments do not present additional claims; instead at least one claim (52) has been canceled in a sincere effort to advance prosecution. Entry of the above amendments to the claims is respectfully requested.

The Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1-19, 21-39, 41, 51, and 52¹ stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the Office Action (pages 2-3), the Examiner stated:

The instant claims have been amended to now contain NEW MATTER. For example, claim 1 now recites several new components made up of various N, M, and B moieties. These arrangements of said components in line 3 of claim 1 have not been found as filed and thus are NEW MATTER. The closest component arrangements to these is present in claim 21 as filed but do not give written description of these arrangements. Claims 2-19, 21-39, 41, 51, and 52 also contain this NEW MATTER either directly or indirectly via dependence from a claim that explicitly contains it. This rejection is necessitated by amendment.

¹ Although they were uncertain as to the basis of the new matter rejection as it applied to claim 52, nevertheless Applicants have canceled claim 52 in a sincere effort to advance prosecution.

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Serial No. 08/479,999

Filed: June 28, 1994

Page 9 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

As indicated in their opening remarks above, Applicants have restored the originally disclosed and claimed components (MN_3M , $B(N)_xM$ and $M(N)_xB$) into the claims at hand.

In view of the above claim language and foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection for new matter.

The First Rejection Under 35 U.S.C. §102(b)

Claims 1, 2, 4, 8, 12-14, 19, and 42-50 are rejected under 35 U.S.C. §102(b) as being anticipated by Miller et al.(1985). In the Office Action (page 3), the Examiner stated:

This rejection is reiterated and maintained from the previous office action, mailed 1/4/99. Applicants argue that Miller et al. neither discloses nor suggests not fully modifying all of the internal phosphodiester linkages and is silent on RNase H sensitivity. This RNase H resistance argument is confusing in that instant claim 1, for example, lacks any mention of RNase H resistance or not. Only claims 44 and 49 as rejected hereinunder cite any RNase H practice and these claims, such as specifically claim 44 directs RNase H resistance to what is complexed with the compound of claim 42 and not the compound itself. This argument is thus non-persuasive as being directed to a limitation that is not in the claims under rejection.

The anticipation rejection is respectfully traversed.

As indicated in the opening remarks above, the present claims are directed to modified *RNase H resistant* nucleotide compounds, which distinguishes from Miller et al.

Accordingly, in light of the above claim amendments, Applicants respectfully request reconsideration and withdrawal of the first anticipation rejection.

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Filed: June 28, 1994

Page 10 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

The Second Rejection Under 35 U.S.C. §102(b)

Claims 1-4, 12-14, and 42-50 stand rejected under 35 U.S.C. §102(b) as being anticipated by Stein et al.(1988). In the Office Action (page 4), the Examiner stated:

This rejection is reiterated and maintained from the previous office action, mailed 1/4/99. Applicants argue again as above regarding RNase H resistance. This argument has been responded to above and is equally applicable here and is reiterated here. Applicants then argue regarding partial internal modification that is not in Stein et al. This is non-persuasive as it is based on the NEW MATTER added to the instant claims. This rejection is reiterated in anticipation of removal of the NEW MATTER thus leaving the claims rejected as before.

The second anticipation rejection is respectfully traversed.

As indicated in the previous anticipation rejection, Applicants are now claiming modified RNase H resistant nucleotide compounds, which distinguishes their claimed invention from either of Miller et al. or the instant Stein et al.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the second anticipation rejection.

The Rejection Under 35 U.S.C. §103(a)

Claims 1-52 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Walder et al.(1988) in view of Miller et al. (4, 469, 863) and Inoue et al. (1988). In the Office Action (page 5), the Examiner stated:

This rejection is maintained and reiterated as given in the office action, mailed 1/4/99. Applicants argue based on the internal partial modification of the claimed compounds which has been noted above as being NEW MATTER. This rejection is reiterated in anticipation of removal of the NEW MATTER thus leaving the claims rejected as before.

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Serial No. 08/479,999

Filed: June 28, 1994

Page 11 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

The obviousness rejection is respectfully traversed.

Applicants respectfully submit that the combination of cited documents would not have rendered their now claimed invention obvious to a person of ordinary skill in the art at the time their invention was made.

Reconsideration and withdrawal of the obviousness rejection is respectfully requested.

Submission of Art-Related Document

Applicants' attorney and his assistant are searching for any additional art-related documents. Should any such document come to light, Applicants intend to submit them in a supplemental information disclosure statement as soon as an indication has been received that this application has been revived.

Submission of Consolidation Amendment

Applicants' attorney is consolidating all pending claims into a clean version. As soon as an indication has been received that the present application has been revived, the undersigned will submit a consolidation amendment including a clean version of the pending claims.

* * * * *

Christine L. Brakel et al.

Serial No. 08/479,999

Filed: June 28, 1994

Page 12 [Amendment Under 37 C.F.R. §1.116 (In Response To The September 26, 2000 Office Action) - December 26, 2001]

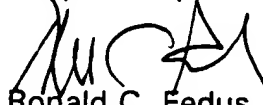
SUMMARY AND CONCLUSIONS

Claims 1-51 as amended hereinabove are presented for further examination on the merits. Replacement claims 1, 18, 19, 21, 37, 41 and 51 have been entered above. Claim 52 has been canceled. No claim has been added by this paper.

This Amendment is accompanied by a Petition Under 37 C.F.R. §1.137(b) and authorization for the fee therefor. No other fee is believed due in connection with this Amendment, including any claim fee since one claim has been canceled and no claims have been added. If any other fee or fees are due, however, the Patent and Trademark Office is authorized to charge the amount of any such fee(s) to Deposit Account No. 05-1135, and to credit any overpayment thereto.

In view of the above discussion of the issues and amendments to the claims, Applicant respectfully submits that all of the instant claims are in allowable condition. Should it be deemed helpful or necessary, the Examiner is respectfully invited to telephone the undersigned at (212) 583-0100 to discuss the subject application.

Respectfully submitted,



Ronald C. Fedus

Registration No. 32,567

Attorney for Applicant

ENZO THERAPEUTICS, INC.

c/o Enzo Biochem, Inc.

527 Madison Avenue, 9th Floor

New York, New York 10017

Tel.: (212) 583-0100

Fax.: (212) 583-0150

CHRISTINE L. BRAKEL ET AL., U.S. PAT. APPL. SER. NO. 08/479,999
MARKED-UP VERSION OF THE AMENDED CLAIMS
Exhibit A [Amendment Under 37 C.F.R. §1.116 -- December 26, 2001]

1. (Four Times Amended) A modified RNase H resistant nucleotide compound which includes at least one component selected from the group consisting of MN_3M , $[(N)_xM(N)_y]$, $(N)_xM(N)_yM$, $B(N)_xM(N)_y$, and $(N)_xM(N)_yB$ $B(N)_xM$ and $M(N)_xB$ wherein

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2[~~;~~and

~~y is an integer~~].

18. (Twice Amended) The modified nucleotide compound of claim 1 which includes at least one sequence of the formula $[(N)_yM(N)_xB]$ $M(N)_xB$ wherein B is modified or unmodified 2',3'-dideoxyribose nucleotide.

19. (Twice Amended) The modified nucleotide compound of claim 1 wherein $[y]$ x is an integer selected from the group consisting of 2 or 2.

Christine L. Brakel et al.

Serial No.: 08/479,999

Filed: June 28, 1994

Page 2 [(Exhibit A to Amendment Under 37 C.F.R. §1.116 --
Marked-Up Version of Claims) - December 26, 2001]

21. (Four Times Amended) A method of inhibiting the function of an RNA, which comprises:

contacting said RNA, under conditions permissive of hybridization, with a modified RNase H resistant nucleotide compound which includes at least one complementary component selected from the group consisting of MN_3M ,

~~$(N)_xM(N)_y$, $(N)_xM(N)_yM$, $B(N)_xM(N)_y$ and $(N)_xM(N)_yB$~~ $B(N)_xM$ and $M(N)_xB$ wherein:

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2; ~~and~~

~~y is an integer~~.

37. (Twice Amended) The method of claim 21 wherein the RNA is contacted with a compound which includes at least one sequence of the formula ~~$(N)_xM(N)_yB$~~ $M(N)_xB$ wherein B is modified or unmodified 2',3'-dideoxyribose nucleotide.

41. (Twice Amended) A method of treating a human or animal so as to inhibit the function of a target RNA therein which method comprises administering a therapeutically effective amount of a modified nucleotide compound so as to inhibit the function of the target RNA, which modified RNase H resistant nucleotide compound includes at least one component selected from the group consisting of

Christine L. Brakel et al.

Serial No.: 08/479,999

Filed: June 28, 1994

Page 3 [(Exhibit A to Amendment Under 37 C.F.R. §1.116 --

Marked-Up Version of Claims) - December 26, 2001]

MN_3M , $[(N)_xM(N)_y, (N)_xM(N)_yM, B(N)_xM(N)_y, \text{ and } (N)_xM(N)_yB]$ $B(N)_xM$ and $M(N)_xB$

wherein:

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2[; ~~and~~

~~y is an integer~~].

51. (Twice Amended) A modified nucleotide compound which comprises at least one component selected from the group consisting of MN_3M , $[(N)_xM(N)_y, (N)_xM(N)_yM, B(N)_xM(N)_y, \text{ and } (N)_xM(N)_yB]$ $B(N)_xM$ and $M(N)_xB$ wherein:

N is a phosphodiester-linked modified or unmodified 2'-deoxynucleoside moiety; provided that at least one N is a phosphodiester-linked unmodified 2'-deoxynucleoside moiety;

M is a moiety that confers endonuclease resistance on said component and that contains at least one modified or unmodified nucleic acid base;

B is a moiety that confers exonuclease resistance to the terminus to which it is attached; and

x is an integer of at least 2[; ~~and~~

~~y is an integer~~].

* * * * *

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christine L. Brakel et al.

Serial No.: 08/479,999

Group Art Unit: 1631

Filed: June 28, 1994

Examiner: Ardin H. Marschel, Ph.D.

Title: **MODIFIED NUCLEOTIDE COMPOUNDS**
(As Previously Amended)

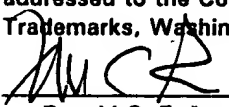
FILED BY EXPRESS MAIL

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

**NOTICE OF APPEAL TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

Sir:

Applicant(s) hereby appeal(s) to the Board of Patent Appeals and Interferences from the decision dated September 26, 2000 of the Primary Examiner, finally rejecting or objecting to claims 1-52.

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	EL491424303US
Deposit Date	December 26, 2001
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231.	
 Ronald C. Fedus Reg. No. 32,567	DEC 26 2001 Date

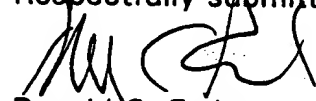
Christine L. Brakel et al.
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Filed: June 28, 1994
Page 2 (Notice of Appeal)

The items checked below are appropriate:

1. X Appeal Fee of \$320.00
2. Fee enclosed.
3. Fee not required (e.g., Fee paid in prior appeal).
4. X Charge Fee to Deposit Account No. 05-1135.
(A DUPLICATE COPY OF THIS SHEET IS ATTACHED.)
5. X The Commissioner is hereby authorized to charge any additional
fees which may be required by this paper, or to credit any
overpayment to Deposit Account No. 05-1135.

December 26, 2001
Date

Respectfully submitted,



Ronald C. Fedus
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